

REMARKS

Claims 1-20 are pending in the application of which claims 12-20 were considered in the office action dated March 26, 2009. (Claims 1-11 were withdrawn in response to the restriction requirement of April 9, 2008.) Of those considered, claims 12 and 18 are in independent form.

Claims 1-2, 6-8, and 10-20 are amended, no claims have been cancelled or added.

Summary of Examiner Interview

Applicants thank Examiner Stephen Blau for courtesies extended to their representative, James C. Larsen, in a telephonic interview conducted April 29, 2009. In the Interview, the participants discussed the Examiner's interpretation of the term "same" in reference the longitudinal bending/stiffness profile of the claimed family of shafts. The Examiner confirmed that he interprets the term "same" to mean "absolutely identical" or "without variation". The Examiner indicated that the claims might be amended, if in conformance with the specification and/or understanding in the industry or by those skilled in the art, to indicate that the longitudinal bending/stiffness profile is *substantially* the same.

Objection to the Specification

The Office Action objects to the specification under 37 C.F.R. 1.71, alleging that one skilled in the art would not be enabled to make the disclosed invention(s). To support this objection, the Office Action points Applicants to page 6, lines 20-25 of the specification, which state, in pertinent part:

... a family of golf club shafts is provided with greatly varying weights and having the same longitudinal stiffness/bending profile by using the same amount and types of zero-ply materials in each shaft of the family, varying the amounts and weights of the angle-ply materials by a selected amount in each shaft....

The Office Action implies that these lines would confuse one skilled in the art because the varying amounts and weights of angle-ply materials would ultimately contribute differences to the longitudinal stiffness profile of each shaft.

Applicants respectfully direct the Examiner's attention to the remainder of the specification, which clearly illustrates that one skilled in art would indeed be enabled to make

and/or use the claimed invention. The objected-to paragraph should not be considered in isolation, and the specification indicates that slight variations in longitudinal bending/stiffness would be recognized by the skilled artisan. For example, Fig. 7 illustrates a representative “Stiffness Profile” that shows “stiffness characteristics that may be achieved, and *substantially uniformly* maintained in a preferred family of shafts according to the present invention. (Page 9, lines 9-11; *see also* page 8, lines 1-4; page 7, lines 18-22; and page 3, lines 6-10.)

Plainly, one skilled in the art could not reasonably conclude that the longitudinal bending/stiffness profiles of a family of shafts must be absolutely identical, and would understand that the profiles may be “substantially” the same.

Nevertheless, in an effort to expedite prosecution and place the claims in exceedingly clear form, the objected-to paragraph is amended to explicitly disclose that which was formerly understood in the context of the full specification. That is, the identified paragraph now indicates that “a family of golf club shafts is provided with greatly varying weights and having substantially the same longitudinal stiffness/bending profile”. In view of at least the specification portions noted above, which provide support for “*substantially* the same longitudinal stiffness/bending profile” among a family of shafts, it is submitted that such amendment does not add new matter. It is noted, however, that “substantially the same” may encompass within its meaning “absolutely identical”, and that variations in processing methods, materials, etc. may purposefully or incidentally result in such identity. Withdrawal of the objection is earnestly and respectfully solicited.

Claim Rejections under § 112

The Office Action maintains the rejection of claims 12-20 under 35 U.S.C. § 112, first paragraph, alleging that the claims fail to comply with that paragraph’s enablement requirement. In particular, the Office Action asserts that slight variations to a longitudinal bending/stiffness profile must result from the claimed differences in preselected weight of angle-fiber-and-resin material in each shaft of said family of shafts.

In view of the specification, discussed above, Applicants disagree with the Examiner’s interpretation that “same longitudinal bending/stiffness profile” must be understood by one of

skill in the art to mean “absolutely identical longitudinal bending/stiffness profile”, and that the skilled artisan would therefore not be enabled to make and/or use the claimed invention. Even if a negligible longitudinal stiffness vector (from angle-ply material) affects a shaft’s stiffness profile, such contribution need not ultimately result in a deviation from a target longitudinal bending/stiffness profile, particularly in view of other small stiffness variations which may be provided in the manufacturing process.

Nevertheless, in order to expedite prosecution, independent claims 12 and 18 are amended to recite explicitly that which was previously implicit in the claims. That is, the claims are variously amended to recite, in part, shafts having “substantially the same longitudinal bending/stiffness profile”. As discussed above, such amendments are plainly supported by the specification, and the claims are believed to still encompass identical stiffness profiles for each shaft in a family of shafts.

Claims 13-17 depend from claim 12, and 19-20 depend from claim 20, and are therefore believed to be in condition for allowance for at least the same reasons as their parent claims. Applicants respectfully request withdrawal of the rejection and allowance of claims 12-20.

Rejoinder of Withdrawn Claims

Claims 1-2 and 6-8 are presently amended consistent with the present amendments to claims 12-20 discussed above. These changes are believed to merely state explicitly that which was previously inherent in the claims in view of the specification. Additional, non-substantive amendments to these claims have been introduced for clarity and to place the claims in better form.

As noted by the Examiner in the Restriction Requirement dated April 9, 2008, once product claims are found allowable, Applicants are entitled to rejoinder of process claims which are of the same scope as the allowed product claims. Product claims 12-20 are believed to be in condition for allowance.

Accordingly, Applicants respectfully request rejoinder and allowance of claims 1-11.

Conclusion

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact James C. Larsen, Reg. No. 58,565 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: June 26, 2009

Respectfully submitted,

By 

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